

REMARKS

I. Introduction

With the addition of claims 17 and 18, claims 8 to 18 are currently pending in this application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 8 to 14 and 16 Under 35 U.S.C. § 103 (a)

Claims 8 to 14 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,949,492 ("Mankovitz") in view of U.S. Patent No. 5,872,926 ("Levac et al."). Applicants respectfully submit that the combination of Mankovitz and Levac et al. does not render obvious the present claims as amended herein for the following reasons.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent claim 8 recites a method for transmitting information between an infrastructure and data users in which the infrastructure includes a service provider and the data users include terminal devices in a motor vehicle and have specific data processing capabilities. As recited, a single data service is made available in a standardized format using the infrastructure and the data from the single data service in the standardized format is adapted to the data processing capabilities of the data users via the interfaces situated in the infrastructure. Support for the amendments to claim 8 may be found, for example, in Figure 2.

The Office Action acknowledges that Mankovitz does not disclose or suggest adapting data to users that have different processing capabilities. The Office Action then asserts that Levac et al. cure this deficiency. However, it is submitted that this is not the case, because Levac et al. do not disclose, or even

suggest, adapting data from a single data service according to the processing capabilities of the data users via interfaces. Rather, Levac et al. refer to protocol converters which merely change a message format from a plurality of sources to be compatible with various communication devices.

Thus, Mankovitz describes a broadcast transmitter 10 that broadcasts signals to receivers 18a, 18b, 18c without regard to processing capabilities of receivers 18a, 18b, 18c and does not even mention different processing capabilities of receivers 18a, 18b, 18c. In stark contrast, Levac et al. mention at col. 3, line 1 “a wide variety of message sources” and mention at col. 3, lines 14 to 16 numerous “[t]ypes of messages [that] include text messages, variable data updates, source commands and requests for data or responses from the communications device.”

In contrast to the foregoing, the subject matter claimed provides a method and system for adapting data from a single data service in a standardized format to the varying processing capabilities of the data users. For example, the Specification of the present application provides:

Interface 7 will then process this data appropriately by processing the map data that is not needed, for example, because the map section made available by data service 4 is too large, to conform to the format that can be displayed in terminal device 2. Only this data is then transmitted via interface 10 to terminal device 2, i.e., terminal device 2 receives in this case also only the data which it can reasonably process further.

(Specification, page 5, lines 25 to 33).

As the subject matter set forth in claim 8 is clearly not disclosed or suggested by the combination of Mankovitz and Levac et al., it is respectfully submitted that the cited references does not render unpatentable claim 8. As claims 9 and 10 depend from claim 8 and therefore include all of the limitations of claim 8, it is respectfully submitted that the combination of Mankovitz and Levac et al. does not render unpatentable claims 9 and 10, which depend from claim 8. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

As independent claim 11 recites a terminal device for a reception of data from an infrastructure that has specific different data processing capabilities for processing the data which the infrastructure makes available, the infrastructure providing the data via interfaces that adapt the standard format data to the different

data processing capabilities of the terminal device and means for transmitting a request signal to the infrastructure via which data is requested from the infrastructure and with which information concerning the different data processing capabilities is transmitted via the terminal device to the infrastructure, it is respectfully submitted the combination of Mankovitz and Levac et al. does not render unpatentable claim 11 for substantially the same reasons given above with respect to the patentability of claim 8.

Since claims 12 to 14 depend from claim 11 and therefore include all of the limitations of claim 11, it is respectfully submitted that Mankovitz and Levac et al. do not render unpatentable these dependent claims for at least the reasons given above in support of the patentability of claim 11. Id.

As independent claim 16 recites features analogous to those of claim 11, it is respectfully submitted that Mankovitz and Levac et al. do not render unpatentable claim 16 for at least the same reasons given above in support of the patentability of claim 11.

III. Rejection of Claim 15 Under 35 U.S.C. § 103(a)

Claim 15 was been rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Mankovitz, Levac et al. and U.S. Published Patent Application No. 2003/0069029 ("Dowling et al."). Applicants respectfully submit that the combination of Mankovitz, Levac et al. and Dowling et al. does not render unpatentable claim 15 for the following reasons.

With respect to U.S. Published Patent Application No. 2003/0069029, the Examiner's attention is directed to the Reply Under 37 C.F.R. § 1.116 filed on November 26, 2003, that clearly demonstrated that U.S. Published Patent Application No. 2003/0069029 does not constitute prior art against the present invention.

Although this point was made clearly and emphatically previously, it is again noted that the present application is a national stage application based on PCT International Application No. PCT/DE98/02407, filed on **August 19, 1998**. Accordingly, the present application has an effective U.S. filing date of **August 19, 1998**, which is earlier than the **April 10, 2003** publication date of U.S. Published Patent Application No. 2003/0069029 and earlier than the earliest U.S. filing data of U.S. Published Patent Application No. 2003/0069029, namely,

November 17, 1998. Furthermore, the present application claims priority to Application No. 197 50 361.6, filed in the Federal Republic of Germany on **November 14, 1997**. A claim for priority to German Application No. 197 50 361.6 was made, inter alia, in the "Combined Declaration and Power of Attorney for Patent Application," filed on May 15, 2000. A certified copy of German Application No. 197 50 361.6 will be filed under separate cover, and a certified translation of German Application No. 197 50 361.6 was submitted to the Office on November 26, 2003.

In view of the foregoing, it is respectfully submitted that U.S. Published Patent Application No. 2003/0069029 does not constitute prior art against the present application. Withdrawal of this rejection is therefore respectfully requested.

IV. New Claims 17 and 18

New claims 17 and 18 have been added herein. It is respectfully submitted that new claims 17 and 18 do not add any new matter and are fully supported by the present application, including the Specification.

It is respectfully submitted that new claims 17 and 18 are patentable over the references relied upon for at least the reason that the references relied upon do not disclose, or even suggest, data services that are configured independently of the data users before transmission data is adapted to the processing capabilities of the data users. The message router of Levac et al. is merely a message router that converts received messages to outgoing messages and does not include data services that are configured independently of the processing capabilities of the users, and thus does not disclose or suggest the features of new claims 17 and 18.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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